



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,511	10/06/2000	Raymond Andersen	P108281-0000	6795

7590                    01/28/2004

Arent Fox Kintner Plotkin & Kahn  
Suite 600  
1050 Connecticut Avenue NW  
Washington, DC 20036-5339

LUKTON, DAVID

ART UNIT	PAPER NUMBER
----------	--------------

1653

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/581,511	ANDERSEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David Lukton	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 December 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 22-74 is/are pending in the application.

4a) Of the above claim(s) 74 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 22,23,25,27,33,60,63 and 68-70 is/are rejected.

7) Claim(s) 24,26,28-32,34-59,61,62,64-67 and 71-73 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1) Notice of References Cited (PTO-892)      4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      6) Other:

Pursuant to the directives of the amendment filed 12/3/03 claims 22 and 73 have been amended. Claims 22-74 remain pending. Claim 74 remains withdrawn from consideration at this time.

Applicants' arguments filed 12/3/03 have been considered and found persuasive. The previously imposed rejections are withdrawn.

Claims 22, 23, 25, 27, 33, 60, 63, 68-70 are now rejected under 35 U.S.C. §102; claims 24, 26, 28-32, 34-59, 61, 62, 64-67, 71-73 are objected to as being dependent on rejected claims.

\*

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

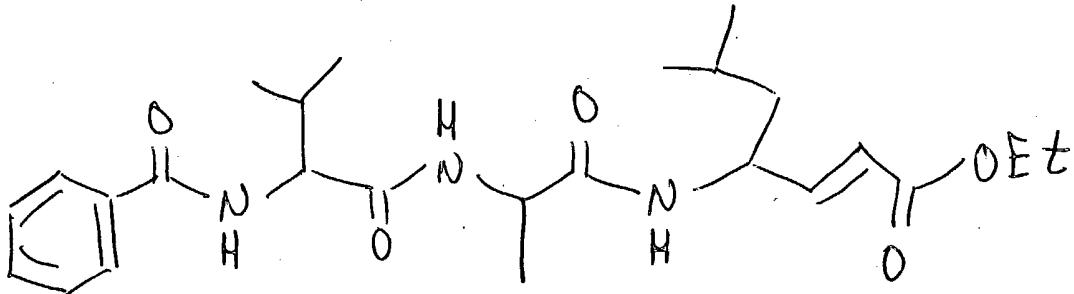
A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22, 23; 27, 60, 63, 68, 70 are rejected under 35 U.S.C. §102(a) as being anticipated by Johnson (WO 97/04004).

Johnson discloses compound 26 (page 74), which has the following structure:



Confirmation of this structure may be obtained by considering the synthesis of the compound (described on pages 39-40). Further confirmation can be obtained by comparison with compound 34 which has been assigned (by Chem Abstracts) the following chemical name:

L-Alaninamide, N-(9H-xanthen-9-ylcarbonyl)-L-valyl-N-[(1S,2E)-4-ethoxy-1-(2-methylpropyl)-4-oxo-2-butenyl]

This compound (containing the xanthene group) has been assigned the registry number 187991-72-6, and the structure is available in the Chem Abstracts database.

The disclosed compound (compound 26, page 74, Johnson) is encompassed by claim 22 when the substituent variables are as follows:

R1 = hydrogen;  
R2 = benzoyl;  
R3 = hydrogen;  
R4 = hydrogen;  
R5 = isopropyl  
R6 = hydrogen  
R7 = methyl  
R8 = hydrogen  
Y = propylene substituted with isobutyl  
Z = -O-CH<sub>2</sub>-CH<sub>3</sub>

Thus, the claims are anticipated.

\*

Claims 22, 23, 25, 33, 60, 68-70 are rejected under 35 U.S.C. §102(b) as being anticipated by Falender (*Biocatalysis and Biotransformation* 13(2), 131-139, 1995).

Falender discloses the following compound on page 134 ("Ag" represents allylglycine):



The disclosed compound is encompassed by claim 22 when the substituent variables are as follows:

R1 = allylglycine;  
R2 = hydrogen;  
R3 = hydrogen;  
R4 = hydrogen;  
R5 = phenyl;  
R6 = hydrogen;  
R7 = benzyl;  
R8 = hydrogen;  
Y = butene;  
Z = -O-CH<sub>2</sub>-CH<sub>3</sub>

As indicated, claim 22 permits R1 to be allylglycine, or more accurately, 1-oxo, 2-amino pent-4-ene. This conclusion is reached because claim 22 recites that R1 can be an unsaturated moiety that is substituted with amino and with oxo. If a pentene group is

substituted with amino and with oxo, the result is an allylglycine residue.

Thus, the claims are anticipated.

\*

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at 571-272-0951. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

D. Lukton 1/20/04

*Christopher S. Low*  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600